

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 12-20 are currently pending. Claims 12 and 19 are independent. The remaining claims depend directly or indirectly from claims 12 and 19.

Claim Amendments

Independent claim 12 is amended by this reply for purposes of clarification. No new matter is added by way of these amendments as support for these amendments may be found, for example, in paragraphs [0044]-[0050] of the Publication of the Specification (U.S. Publication No. 2007/0028261).

Rejection(s) under 35 U.S.C. § 102

Claim 12 is rejected under 35 U.S.C. § 102(e) as being anticipated by US Publication No. 2003/0229531 ("Heckerman"). To the extent that this rejection may still apply to the amended claims, this rejection is respectfully traversed.

For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. *See* MPEP § 2131. The Applicant respectfully asserts that Heckerman does not disclose each and every limitation recited in the amended independent claim.

Amended independent claim 12 recites, in part, (i) a probable value associated with each association of an advertisement space with an advertisement, and (ii) attributing a range of

values to each probability value received in the STB, wherein the range of values corresponding to each probability value is attributed so as to avoid overlap with distinct associations comprising the determined advertisement space. *See* Publication of present application, paragraphs [0044]-[0050].

Turning to the rejection, Applicants respectfully assert that Heckerman fails to disclose attributing a range of values to each probability value of an association contained in the advertisement selection information received in the STB. Heckerman discloses that each advertisement is associated with a “response (or mouse click) probability.” *See* Heckerman, paragraph [0012]. The response probability of Heckerman represents the probability that a user using a computer system clicks on the advertisement to view the advertisement or to go to a webpage associated with the advertisement. Heckerman fails to disclose attributing a range of values to the response probability for each advertisement. Rather, Heckerman discloses a score associated with each advertisement. A numerical score is clearly not *a range of values*. Furthermore, it logically follows that because Heckerman does not associate each probability value with a separate range of values, it does not make sense for Heckerman to attribute the range of values such that no overlap occurs between advertisements to be selected for the same advertisement space, as required by the claims.

In addition, Heckerman fails to disclose a plurality of associations of advertisements with advertisement spaces, as clearly recited in amended claim 12. Rather, Heckerman discloses only one association of an advertisement space with an advertisement.

Finally, Heckerman also fails to disclose generating a random value that selecting an advertisement based on which range of values the random value falls within. The Examiner asserts that the probability determination module (261), or alternatively, the alteration module

(262), generate a random value. However, firstly, both of the aforementioned components of Heckerman are within the advertising computer and not in the user computer. This directly contradicts the claimed invention, which clearly recites that the random value is generated in the STB (which the Examiner equates with the user computer in Heckerman). Furthermore, any random value generated in Heckerman is not compared to a range of values to determine which advertisement to select, because it is clear that Heckerman does not associate a range of values with each association in the advertisement selection information.

In view of the above, it is clear that amended independent claim 12 is patentable over Heckerman, as Heckerman fails to disclose each and every limitation recited in claim 12. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection(s) under 35 U.S.C. § 103

Claims 13-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Heckerman in view of US Publication No. 2006/0029368 ("Harville"). To the extent that this rejection may still apply to the amended claims, this rejection is respectfully traversed.

MPEP § 2143 states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." Further, when combining prior art elements, the Examiner "must articulate the following: (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference...." MPEP § 2143(A).

Claims 13-18, which depend directly or indirectly from claim 12, are patentable over Heckerman for at least the same reasons described above with respect to claim 12. Further, Harville fails to supply that which Heckerman lacks, as evidenced by the fact that the Examiner relies on Harville solely for the purpose of teaching that the probability value for an advertisement depends on the number of times the advertisement is to be displayed. *See* Office Action mailed October 16, 2008, page 5-6. Thus, dependent claims 13-18 are patentable over Heckerman and Harville, whether considered separately or in combination.

With respect to independent claim 19, Heckerman fails to teach or suggest determining a *final number of selections* for a particular advertisement space. Rather, Heckerman merely teaches determining a response probability, which as described above, is based on a user selecting an advertisement displayed on a computer system, and has nothing to do with advertisement *spaces*, as required by claim 19. Moreover, the response probability is not a “final number of selections;” rather, it is merely a probability of how often the advertisement is selected by a user. In addition, as described above, Heckerman fails to teach or suggest a plurality of associations of advertisement spaces with advertisements to be selected.

Dependent claim 20 is patentable over Heckerman for at least the same reasons described above with respect to independent claim 19. Further, Harville fails to supply that which Heckerman lacks, as evidenced by the fact that the Examiner relies on Harville solely for the purpose of teaching that the probability value for an advertisement depends on the number of times the advertisement is to be displayed. *See* Office Action mailed October 16, 2008, page 6.


Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 11345/063001).

Dated: January 13, 2009

Respectfully submitted,

By  #45,079
Jonathan P. Osha THOMAS SCHERER
Registration No.: 33,986
OSHA - LIANG LLP
909 Fannin Street, Suite 3500
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicant